

*** * REASONS FOR AMENDMENTS AND REMARKS * ***

In response to the Office Action dated February 4, 2005, Applicants have canceled Claims 1-18, without prejudice as to the subject matter of those claims, and have added new Claims 19-32. For the reasons set forth below, Applicants respectfully request prompt consideration and allowance of these new claims.

Claims 1-18 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In paragraph 8 on page 5 of the Detailed Action, the Examiner states:

Claims 1-18 appear to be describing a method for developing business ideas into a marketable product. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a “tangible” process and, therefore, non-statutory subject matter.

On page 9 of the Detailed Action, the Examiner acknowledges a reference to “technological arts” recited in the preamble of the claims, but notes that such does not confer statutory subject matter to the claim, absent a “positive recitation in the claim as a whole to breath life and meaning into the preamble.”

In partial response to this rejection, Claims 1-18 have been canceled (without prejudice as to the subject therein) and new Claims 19-32 have been added. Claims 19-32 have been drafted so as to more clearly point out and claim the subject matter which Applicants regard as the invention, and to more clearly define the statutory subject matter. The claims are method claims. Statutory subject matter under 35 U.S.C. § 101 is defined as “any new and useful process, machine, manufacture, or composition of matter” 35 U.S.C. § 100(b) defines the term process as follows:

The term “process” means process, art or method, and includes a

new use of a **known** process, machine, manufacture, composition of matter, or material. (emphasis added)

Applicants respectfully submit that the claimed method (or process) does not need to include “a distinguishable apparatus, computer implementation, or any other incorporated technology” as indicated by the Examiner. The invention is directed to one of the four classes of patentable subject matter defined by 35 U.S.C. § 101. Thus, the inquiry should be restricted to whether the claimed process is “new and useful.” Both of these requirements are addressed below.

Applicants respectfully submit that the invention is not “a method for developing business ideas into a marketable product” as stated by the Examiner. Rather, the invention is a method for systematically adding structure to a plurality of potentially disparate elements of information which are associated with a relatively unstructured domain defined by the user of the method. The addition of “structure” to the relatively unstructured elements of the domain is done for the purpose of, and only on the condition of, imparting added value to the domain. As set forth in new Claim 19, the method comprises the steps of:

- identifying a plurality of elements of information associated with an unstructured domain;
- developing an initial domain model for utilizing the plurality of elements of information associated with the domain to create value;
- developing an estimate of costs associated with developing a knowledge map cataloging and describing at least some of said elements of information associated with the domain, and developing an estimate of the value of said knowledge map;
- comparing the estimates of costs and value and, based on said comparison, performing at least one of the steps of:

storing and maintaining said model and said
plurality of elements of information; and
developing and storing the knowledge map so as to
add structure and impart value to said domain.

Applicants respectfully submit that newly-submitted Claims 19-32 define subject matter that is within the “technological arts” (or “useful arts”). That is, Claim 19 sets forth the steps of a method for systematically providing an increased degree of order or structure to a user-selected body of unordered (i.e., unstructured) information associated with a particular domain or body of knowledge. This is useful. In the claimed method, additional order is provided only after a comparison of estimates of costs and value associated with the increased order. This too is useful, and the results are concrete and tangible. Dependent Claims 27 and 31 set forth additional steps for systematically providing ever-increasing degrees of order to the selected domain after comparisons of estimated costs and values associated with each of the increased degrees of order. Applicants again respectfully submit that these results are not only “concrete and tangible,” but “useful” as well. For these reasons, Applicants believe that each of these claims defines a method in the technological or useful arts and defines statutory subject matter under 35 U.S.C. § 101.

Claims 1-18 were also rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,044,354 to Asplen, Jr. (hereafter “Asplen”). As previously noted, the Examiner states in paragraph 8 of the Detailed Action that original Claims 1-18 “appear to be describing a method for developing business ideas into a marketable product.” Applicants respectfully submit that such description does not accurately describe the subject matter of the present application (as will hopefully be more apparent in view of newly added Claims 19-32). However, such description does fairly characterize the subject matter disclosed by Asplen. The Asplen patent discloses a computer based “product planning system.” The Asplen system is said to provide “for uniform product planning throughout an organization while insuring

thoroughness, control and rapid implementation.” (Abstract) It includes “chapters” on idea assessment, market opportunity assessment, business planning, implementation planning and product launch, with listings of associated tasks that may be customized for particular products. Applicants respectfully submit that the computer system disclosed by Asplen is a specialized system directed to a particular task (i.e., product development). As such, the Asplen system differs markedly from the method claimed in newly-submitted Claims 19-32.

Applicants claimed invention is directed to a method of structuring (or adding structure to) the contents of an unstructured domain (or body of knowledge) so as to impart or add value to the domain. The domain of interest is defined by the user. The steps include identifying plural elements of information associated with the unstructured domain, developing an initial domain model for utilizing those elements to create value, developing an estimate of costs associated with adding structure (e.g., developing a knowledge map) for at least some of those elements of information, and developing an estimate of the added value. The estimates of costs and value are compared and, based on that comparison, at least one of the steps of storing and maintaining the model and elements of information, and developing and storing the knowledge map so as to add structure and impart added value to the domain are performed. Applicants respectfully submit that such a method is neither disclosed nor suggested by Asplen. With specific reference, for instance, to the steps in Claim 19 relating to a “knowledge map,” such is defined on page 8 of the specification as a device for structuring the content scope of the domain by cataloging and describing the key content sources in the domain. Asplen does not disclose or suggest a system or method which includes the step of developing such a knowledge map. The same is true in relation to the “knowledge clearing house” of dependent Claim 27 and the “knowledge network” of dependent Claim 31. Asplen neither discloses nor suggests a system/method which incorporates any of these elements.


Even if the user-selected domain of the presently-claimed method happened to be new product planning and development, Applicants respectfully submit that the methods of

Claims 19-32 are patentably distinguishable from the system described by Asplen. For example, those claims require developing estimates of costs associated with structuring (e.g., developing a knowledge map or clearing house) the plurality of elements of information identified as being associated with the domain. The method then requires comparing the estimates of costs and value and proceeding with developing the additional structure on the basis of that comparison. The system disclosed by Asplen may include defined tasks which are intended to determine whether a new product would be cost effective to produce. However, that is very different from determining whether to develop, for example, a knowledge map for a plurality of identified elements of information associated with a particular body of knowledge. Accordingly, Applicants respectfully submit that newly-submitted claims 19-32 define a new (and useful) process, and are patentable over Asplen.

A sincere and earnest effort has been made to completely address and respond to each of the issues raised by the Examiner in the Office Action. If, upon consideration of the above, the Examiner feels that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact Applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. To the extent additional fees are required, please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 02-1010 (26893/82373) and please credit any excess fees to such deposit account.

Respectfully submitted,



Bobby B. Gillenwater
Reg. No. 31,105
Direct Line (260) 425-4649
FWDS01 BBG 195136v1